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PATENT  
Attorney Docket No.: 068029-5005

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:	)	
	)	
Miles Stephen CAIN et al.	)	Confirmation No.: 5886
	)	
Application No.: 10/549,877	)	Group Art Unit: 1794
	)	
Filed: December 19, 2005	)	Examiner: Victor S. Chang
	)	
For: ADHESIVE FABRIC	)	<b>Mail Stop Appeal Brief Patents</b>
	)	

Commissioner for Patents  
**Mail Stop Appeal Brief Patents**  
Alexandria, VA 22314

Madam:

**APPELLANT'S BRIEF UNDER 37 C.F.R. § 41.37 TRANSMITTAL FORM**

1. Transmitted herewith is an Appeal Brief Under 37 C.F.R. § 41.37 which is being submitted further to the Notice of Appeal filed December 2, 2008.
2. Additional papers enclosed:
  - ☐ Request for Presence at the Appeal Conference
  - ☐ Form PTO-1449, \_\_\_\_\_ references included
  - ☐ Citations
  - ☐ Declaration of Biological Deposit
  - ☐ Submission of "Sequence Listing", computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.

## 3. Oral Hearing Under 37 C.F.R. § 41.47

- ☐ Oral hearing is hereby requested.  
☐ Fee under 37 C.F.R. § 41.20(b)(3) is enclosed.

4. Extension of Time

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136(a) apply.

- ☒ An extension of time was previously secured. Applicant believes that no additional extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.
- ☐ Applicants petition for an extension of time, the fees for which are set out in 37 C.F.R. § 1.17(a), for the total number of months checked below:

<u>Total Months Requested</u>	<u>Fee for Extension</u>	<u>[Fee for Small Entity]</u>
<input type="checkbox"/> one month	\$ 130.00	\$ 65.00
<input type="checkbox"/> two months	\$ 490.00	\$ 245.00
<input type="checkbox"/> three months	\$ 1,110.00	\$ 555.00
<input type="checkbox"/> four months	\$ 1,730.00	\$ 865.00

Extension of time fee due with this request: \$\_\_\_\_\_.

If an additional extension of time is required, please consider this a Petition therefor.

- ☐ An extension for \_\_\_\_\_ months has already been secured and the fee paid therefor of \$\_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

5. Constructive Petition

- ☒ EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

6. Fee Payment

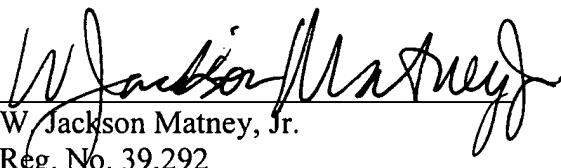
- ☐ No fee is to be paid at this time.
- ☒ Please charge Deposit Account No. 50-0310 the amount of \$540.00 for filing a brief in support of an Appeal.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, including fees due under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account 50-0310.

Respectfully submitted,

**MORGAN LEWIS & BOCKIUS LLP**

Dated: February 2, 2009

By:

  
W. Jackson Matney, Jr.  
Reg. No. 39,292

**CUSTOMER NO. 009629**  
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(202) 739-3000



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Commissioner for Patents  
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Alexandria, VA 22314

Sir:

**APPELLANTS' BRIEF UNDER 37 C.F.R. § 41.37**

This brief is in furtherance of the Notice of Appeal, filed in the above-identified patent application on December 2, 2008. A fee of \$540.00 required under 37 C.F.R. § 41.20(b)(2) is filed concurrently herewith. The period for filing this brief extends through February 2, 2009. This Brief is submitted in the format specified in the current rules, rather than the format specified in the rules originally scheduled to become effective December 10, 2008. As announced in the Federal Register on December 10, 2008, either format is acceptable.

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**1. Real Party in Interest**

The real party in interest in this appeal is Stretchline Intellectual Properties Limited of Tortola, British Virgin Islands.

**2. Related Appeals and Interferences**

Appellants are not aware of any other appeals or interferences that may be related to, directly affect, or be directly affected by or have a bearing on the Board's decision in this appeal.

**3. Status of Claims**

The status of the claims is as follows upon filing of this Appeal Brief:

Claims rejected: 1-3 and 20-47.

Claims allowed: None.

Claims withdrawn from consideration but not canceled: 4-13, 16, and 17.

Claims objected to: None.

Claims canceled: 14, 15, 18, and 19.

Claims pending: 1-3 and 20-47.

The claims on appeal are 1-3 and 20-47.

**4. Status of Amendments**

No amendments have been filed subsequent to final rejection.

**5. Summary of Claimed Subject Matter**

Aspects of Appellants' present invention relate generally to an adhesive fabric that adheres to the body. The present invention, as summarized below, is generally described at page 8, lines 10-19 of the specification with reference to Figure 4.

As illustrated in Figure 4, and in one embodiment, an adhesive fabric 10 capable of adhering to the skin of a body comprises an impervious barrier layer 12 bonded on one side of a fabric substrate 11 and a cured adhesive silicone gel layer 13 bonded to the barrier layer 12 whereby the barrier 12 prevents absorption of the adhesive silicone gel 13 coating into the fabric substrate 11. In the one embodiment, the barrier layer 12 is impervious, and therefore impossible to penetrate. Further, in the one embodiment, the barrier layer 12 prevents absorption of uncured silicone gel 13 into fabric substrate 11 as provided at page 3, lines 19-21, where Appellants state that "the silicone gel is extruded onto the silicone elastomer [barrier layer 12] before it is cured so that curing of both the silicone elastomer and gel is performed simultaneously." *See also*, p. 13, ll. 4-7; p. 13, ll. 11-12 ("Without first coating the substrate with the barrier the silicone gel would penetrate through the fabric substrate."). In the absence of barrier layer 12, the silicone gel 13 would absorb into fabric substrate 11.

**6. Grounds of Rejection to be Reviewed on Appeal**

The ground of rejection to be reviewed on appeal is whether claims 1-3 and 20-47 are unpatentable under 35 U.S.C. § 103(a) over U.S. Publication No. 2002/0120972 to Nakamura et al. ("*Nakamura*") in view of U.S. Patent No. 6,200,195 to Furuno et al. ("*Furuno*").

## 7. Argument

Appellants respectfully assert that the rejections under 35 U.S.C. § 103 are improper and should be reversed for at least the following reasons.

Before discussing the claims of the current invention, Appellants provide a brief discussion of *Nakamura* here. The object of *Nakamura* is to facilitate manufacturing of a sag-preventive member while avoiding the problem of applying liquid silicon gum to a fabric, which may exude through the fabric. *Nakamura*, Abstract, par. [0003]. The solution that *Nakamura* provides is the manufacture of a layer sheet by laminating an adhesive layer and a film layer. *Nakamura* par. [0045]. The layer sheet is then installed to an article of clothing either by sewing or by heating, where the film layer is a hot-melt layer. *Nakamura* par. [0049]-[0053]. Thus, *Nakamura* avoids the stated problems relating to the application of liquid silicon gum to a fabric by not using it in his invention. In other words, *Nakamura* does not disclose the application of an uncured adhesive layer to an article of clothing, either directly, or indirectly and, as such, does not contemplate a barrier layer to prevent the absorption of anything.

### A. Independent Claim 1

Independent claim 1 recites a combination including “an impervious barrier layer bonded on one side of a fabric substrate.” For the purposes of this Appeal, the dependent claims stand or fall with independent claim 1, and are not argued separately. With respect to independent claim 1, the Advisory Action alleges that flexible film layer 11 of *Nakamura* reads on an impervious barrier layer as claimed. Appellants respectfully disagree. Flexible film layer 11 has vent holes. See *Nakamura*, par. [0036]. Therefore, flexible film layer is clearly not “impervious.” The Advisory Action interprets the term “impervious” as meaning “that the barrier layer has sufficient thickness for preventing the adhesive silicone gel from being absorbed into the fabric

substrate through its thickness direction when the sag preventing member is laminated to a fabric under pressure and heat.” Advisory Action, p. 2. This interpretation is not consistent with the plain meaning of the term “impervious.” As stated in the Amendment dated April 17, 2008 at page 3, “impervious” is defined as “[i]mpossible to penetrate.” Further, it is unclear why the Advisory Action limits the interpretation to situations where “the sag preventing member is laminated to a fabric under pressure and heat” because the current invention is not so limited as it contemplates other means of adhering the barrier layer and adhesive layer to the fabric. *See, e.g.*, specification, p. 12, l. 15 – p. 13, l. 7.

Second, claim 1 recites “whereby the barrier prevents absorption of the adhesive silicone gel coating into the fabric substrate.” The Advisory Action states that flexible film layer 11 of *Nakamura* reads on a barrier as claimed. Appellants respectfully disagree. Flexible film layer 11 does not prevent absorption of the adhesive layer 12 into the fabric substrate. As discussed at least in the Response under 37 C.F.R. § 1.116 dated October 6, 2008, the adhesive layer is cured prior to the installation of the layer sheet. *See Nakamura* par. [0045]-[0047]. The adhesive layer would not absorb in the fabric, with or without the presence of flexible film layer 11 because it is cured. Therefore, flexible film layer 11 cannot be a barrier as claimed.

The Final Office Action dated June 4, 2008, citing paragraph [0066] of *Nakamura*, states, “The hot melt flexible film layer avoids exuding a liquid silicone rubber on the outer surface of the clothing thereby maintaining its appearance.” First, paragraph [0066] states “liquid silicon gum” not “liquid silicone rubber.” Second, and more importantly, the Examiner has an incorrect interpretation of *Nakamura*. Paragraph [0066] of *Nakamura* discusses how the use of a hot melt film layer renders the application of a liquid silicon gum to a fabric unnecessary. No use of silicone gel is contemplated. *Nakamura* does not disclose that the hot melt film layer, itself,



prevents the exuding of a liquid silicon gum onto clothing. Therefore, flexible film layer 11 does not “prevent[] absorption of the adhesive silicone gel coating into the fabric substrate” because there is no silicone gel coating contemplated by *Nakamura* that could be absorbed as the adhesives are cured prior to the film layer contacting the fabric.

For at least these reasons, Appellants submit that independent claim 1 is in condition for allowance.

#### B. Dependent Claims

While not arguing the dependent claims separately, Appellants submit that dependent claims 2, 3, and 20-47 are allowable at least because of their respective dependencies from independent claim 1 and the reasons set forth above.

#### C. Conclusion

In view of the foregoing, Appellants respectfully request the reversal of the Examiner’s rejection and allowance of all pending claims. If there are any other fees due in connection with the filing of this Appellants’ Brief, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above,

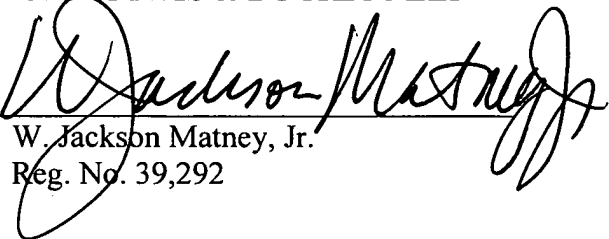
such an extension is requested and the fee should also be charged to our Deposit Account

No. 50-0310.

Respectfully submitted,  
**MORGAN LEWIS & BOCKIUS LLP**

Dated: February 2, 2009

By:

  
W. Jackson Matney, Jr.  
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**8. Claims Appendix**

1. (Previously Presented) An adhesive fabric capable of adhering to the skin of a body, comprising: an impervious barrier layer bonded on one side of a fabric substrate and a cured adhesive silicone gel layer bonded to the barrier layer whereby the barrier prevents absorption of the adhesive silicone gel coating into the fabric substrate.

2. (Original) The adhesive fabric as claimed in claim 1 wherein the barrier material is a silicone elastomer.

3. (Original) The adhesive fabric as claimed in claims 1 or 2 wherein the silicone elastomer has a viscosity of between 50,000 and 150,000 MPas in its uncured state.

4. (Withdrawn) A method for manufacturing an adhesive fabric including: extruding a layer of a curable barrier material onto a fabric substrate; curing the barrier material to form a barrier layer; extruding a layer of a curable adhesive silicone gel on top of the barrier layer and curing the adhesive silicone gel.

5. (Withdrawn) A method according to claim 4 wherein the adhesive silicone gel is extruded onto the extruded barrier material prior to curing of the barrier material.

6. (Withdrawn) A hose having a tubular body formed from a fabric, the tubular body having at one end a leg opening, the fabric in the region of the leg opening being provided with an adhesive coating capable of adhering to the skin of a wearer.

7. (Withdrawn) A hose according to claim 6 wherein the adhesive coating is formed into a band which extends circumferentially about the leg opening.

8. (Withdrawn) A hose according to claim 7 wherein the band extends continuously around the entire circumference of the leg opening.
9. (Withdrawn) A hose according to claim 6 wherein the adhesive coating is formed into discrete regions spaced about the circumference of the leg opening.
10. (Withdrawn) A hose according to any of claims 6 to 9 wherein the region of fabric carrying said adhesive coating is a separate strip of fabric attached to the remainder of the tubular body.
11. (Withdrawn and Previously Presented) A hose according to any of claims 6 to 9 wherein the fabric carrying the adhesive coating is a knitted, woven or non-woven fabric.
12. (Withdrawn) A hose according to claim 11 wherein the fabric carrying the adhesive coating is a knitted fabric which is knitted from non-elastomeric yarns only.
13. (Withdrawn) A hose according to claim 11 wherein the fabric carrying the adhesive coating is a knitted fabric which includes elastomeric yarn to provide the fabric with a desired modulus of elasticity.
14. (Cancelled).
15. (Cancelled).
16. (Withdrawn and Previously Presented) A hose according to claim 6 to 9 wherein the adhesive is an acrylic adhesive.

17. (Withdrawn and Previously Presented) A hose according to claim 6 to 9 wherein the adhesive is a cured silicone gel.
18. (Cancelled).
19. (Cancelled).
20. (Previously Presented) The adhesive fabric as claimed in claim 1, wherein the barrier layer has a thickness in a range of 0.05 to 0.5 mm.
21. (Previously Presented) The adhesive fabric as claimed in claim 2, wherein the barrier layer has a thickness in a range of 0.05 to 0.5 mm.
22. (Previously Presented) The adhesive fabric as claimed in claim 3, wherein the barrier layer has a thickness in a range of 0.05 to 0.5 mm.
23. (Previously Presented) The adhesive fabric as claimed in claim 1, wherein the barrier layer has a thickness in a range of 0.1 to 0.3 mm.
24. (Previously Presented) The adhesive fabric as claimed in claim 2, wherein the barrier layer has a thickness in a range of 0.1 to 0.3 mm.
25. (Previously Presented) The adhesive fabric as claimed in claim 3, wherein the barrier layer has a thickness in a range of 0.1 to 0.3 mm.
26. (Previously Presented) The adhesive fabric as claimed in claim 1, wherein the barrier layer has a thickness in a range of 0.15 to 0.225 mm.

27. (Previously Presented) The adhesive fabric as claimed in claim 2, wherein the barrier layer has a thickness in a range of 0.15 to 0.225 mm.

28. (Previously Presented) The adhesive fabric as claimed in claim 3, wherein the barrier layer has a thickness in a range of 0.15 to 0.225 mm.

29. (Previously Presented) The adhesive fabric as claimed in claim 1, wherein the barrier layer has a thickness in a range of 0.1 to 0.5 mm.

30. (Previously Presented) The adhesive fabric as claimed in claim 2, wherein the barrier layer has a thickness in a range of 0.1 to 0.5 mm.

31. (Previously Presented) The adhesive fabric as claimed in claim 3, wherein the barrier layer has a thickness in a range of 0.1 to 0.5 mm.

32. (Previously presented) The adhesive fabric as claimed in claim 1, that is used in lingerie.

33. (Previously presented) The adhesive fabric as claimed in claim 2, that is used in lingerie.

34. (Previously presented) The adhesive fabric as claimed in claim 20, that is used in lingerie.

35. (Previously presented) The adhesive fabric as claimed in claim 21, that is used in lingerie.

36. (Previously presented) The adhesive fabric as claimed in claim 29, that is used in lingerie.

37. (Previously presented) The adhesive fabric as claimed in claim 30, that is used in lingerie.

38. (Previously presented) The adhesive fabric as claimed in claim 32, wherein the lingerie is a strapless bra.

39. (Previously presented) The adhesive fabric as claimed in claim 33, wherein the lingerie is a strapless bra.

40. (Previously presented) The adhesive fabric as claimed in claim 34, wherein the lingerie is a strapless bra.

41. (Previously presented) The adhesive fabric as claimed in claim 35, wherein the lingerie is a strapless bra.

42. (Previously presented) The adhesive fabric as claimed in claim 36, wherein the lingerie is a strapless bra.

43. (Previously presented) The adhesive fabric as claimed in claim 37, wherein the lingerie is a strapless bra.

44. (Previously Presented) The adhesive fabric as claimed in claim 1, wherein the adhesive fabric is used as straps to hold in place garments or prostheses.

45. (Previously Presented) The adhesive fabric as claimed in claim 2, wherein the adhesive fabric is used as straps to hold in place garments or prostheses.

46. (Previously Presented) The adhesive fabric as claimed in claim 3, wherein the adhesive fabric is used as straps to hold in place garments or prostheses.

47. (Previously Presented) The adhesive fabric as claimed in claim 20, wherein the adhesive fabric is used as straps to hold in place garments or prostheses.



9. **Evidence Appendix**

none

**10. Related Proceedings Appendix**

none